



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,807	12/07/1999	John Beezer	3797.84618	5593

28319 7590 06/15/2004

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
ELEVENTH STREET
WASHINGTON, DC 20001-4597

EXAMINER

SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
----------	--------------

2174

28

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/455,807

Applicant(s)

BEEZER ET AL.

Examiner

Steven P Sax

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>27</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined. The amendment filed 3/30/04 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (6389434) and Strahorn et al (5933140)

4. Regarding claim 1, Rivette et al show a computer implemented method for annotating a system (abstract, Figures 6a, 7a-b, 20, column 4 lines 1-10). The system has a display for displaying an immutable (non-modifiable) page of a document having objects (column 10 lines 17-25, column 9 lines 27-40). The system receives an indication that an object is to be annotated in the page of the document (column 11 lines 10-20, Figures 15, 16, 17, column 12 lines 45-50), and provides a window to the user

Art Unit: 2174

having a portion for receiving the annotation of the object and a portion for allowing navigation to another object annotation (column 11 lines 33-38, 43-48, 55-65, column 12 lines 43-68, column 13 lines 29-35). Rivette et al do not show directly navigating to the other annotation, but rather go through the object. Nevertheless, Rivette et al mention efficient navigation of sub-notes. Furthermore, Strahorn show efficient navigation of help sub-notes by direct navigation between the sub-notes (Figure 3, column 4 lines 8-30 and 45-59). It would have been obvious to a person with ordinary skill in the art to have the direct navigation between the annotations, because it would provide an efficient navigation of sub-notes.

5. Regarding claim 2, the system receives a selection of the object and a menu item is selected to provide the window (for example Figures 9, 16, column 14 lines 15-24).

6. Regarding claim 3, the system receives user input and displays another annotation (column 13 lines 10-15).

7. Regarding claim 4, the non modifiable document page is maintained irrespective of the annotation display (column 15 lines 15-26).

8. Regarding claims 5-6, multiple annotations may be made, in which then multiple non modifiable pages are displayed which may overlie (column 11 lines 25-50, Figure 30, 31b, 32, column 15 lines 35-47, column 17 lines 14-24).

9. Claims 13-18 have the same features as claims 1-6 and are rejected for the same reasons.

10. Regarding claim 25, in addition to the aforementioned, note the storage device (column 9 lines 58-68) which implicitly determines the file position of the object in order to access it (column 10 lines 1-7).

11. Regarding claim 28, in addition to the reasons given for claim 25, note also the data fields (column 19 lines 30-60).

12. Regarding claim 7, in addition to the aforementioned, Rivette et al do not specifically mention displaying an indication that the text annotation has been stored in conjunction with an object on the non modifiable page, but as shown above the annotation is displayed in conjunction with an object on the page. The system also has storage capabilities and furthermore retrieves and loads annotations (column 12 lines 60-68 and column 13 lines 1-16) in an organized way. It would have been obvious to a person with ordinary skill in the art to store the annotation with the object on the page, because it would provide a convenient way to later retrieve and load the annotations in an organized way.

Art Unit: 2174

13. Regarding claim 8, the position of the object is determined (Figures 7a, 8, 9, 10).

It would have been obvious to a person with ordinary skill in the art to store the position and annotation in a separate area from the document, because it would provide a convenient way to later retrieve the information in an organized way.

14. Regarding claims 9 and 10, note the stylus and mouse (column 10 lines 28-32, column 14 lines 30-38).

15. Regarding claims 11 and 12, in addition to the aforementioned, it would have been obvious to a person with ordinary skill in the art to count bytes to determine the position of the object, because it would provide a thorough way to track a position for later retrieval. This may be accomplished by counting bytes from the beginning of the page to the annotation, using another object as a middle point.

16. Claims 19-20 show the same features as 7-8 and are rejected for the same reasons. In addition, it would have been obvious to a person with ordinary skill in the art to store the annotation and position in a modifiable portion of the document, because it would provide convenient retrieval to mutually modifiable portions.

17. Claims 21-24 and 26-27, 29-30 show the same features as 1-12 and are rejected for the same reasons.

Art Unit: 2174

18. Applicant's arguments filed have been fully considered but they are not persuasive. The crux of applicant's arguments lies in the interpretation of the combination of Rivette and Strahorn. Examiner disagrees with the contention that the combination would be merely the navigation of objects from Rivette by the control buttons of Strahorn. Nevertheless, the claim language is still broad, and Strahorn does show navigation between notes, even if those notes themselves are HTML based. The combination of references also shows the dependent claim features as explained above.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2174

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P Sax whose telephone number is 703-305-9582. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEVEN SAX
PRIMARY EXAMINER